

Application Number 09/680,998
Responsive to Office Action mailed August 15, 2006

NOV 15 2006

REMARKS

This submission is responsive to the Office Action dated August 15, 2006. Applicant has not amended the claims. Claims 1, 2, 4-19, 21-40 and 42 remain pending.

Claim Rejection Under 35 U.S.C. § 112

In the Office Action, the Examiner rejected independent claims 1, 19 and 33 under 35 U.S.C. § 112, first paragraph, for lack of both written description support and enablement. More particularly, the Examiner argued that the limitation "after transmitting the modified web page source data to the remote client, transmitting the original web page source data to the remote client including the characters that were removed" in claim 1, as well as the similar limitations of claims 19 and 33, were not supported or enabled by Applicant's specification.

Applicant respectfully traverses these rejections. Applicant's specification and claims as originally filed expressly support the identified limitation, and would have enabled one of ordinary skill to practice the invention defined by claims 1, 19 and 33, including the identified limitation, without undue experimentation.

Written Description

The written description requirement is satisfied if the specification describes the claimed invention in sufficient detail such that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention at the time of filing of the application.¹ A satisfactory description may be in the claims or any other portion of the originally filed specification.² Furthermore, the subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.³ The subject matter may be supported through express, implicit, or inherent disclosure.⁴

¹ See, e.g., MPEP 2163(I), citing *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003).

² MPEP 2163(I)

³ MPEP 2163.02

⁴ MPEP 2163 (I)(B)

Application Number 09/680,998
Responsive to Office Action mailed August 15, 2006

The limitation “after transmitting the modified web page source data to the remote client, transmitting the original web page source data to the remote client including the characters that were removed” of claim 1, and the similar limitations of claims 19 and 33, are expressly supported by the specification and claims as originally filed. For example, these limitations are expressly supported by claim 4 as originally filed. Substantially similar to the recitations in claims 1, 19 and 33, claim 4 as originally filed recited “sending an original, unfiltered version of the requested web page source data to the remote client.”

As stated in the MPEP, the rejection of an original claim for lack of written description should be rare.⁵ The identified limitations of claims 1, 19 and 33 as currently pending are expressly supported by a claim as originally filed. Thus, the rejection of claims 1, 19 and 33 should be withdrawn absent some extraordinary showing of lack or support for the limitation “after transmitting the modified web page source data to the remote client, transmitting the original web page source data to the remote client including the characters that were removed” of claim 1, as well as the similar limitations of claims 19 and 33, elsewhere in the specification.

The Examiner has made no such showing. In fact, the identified limitations of claims 1, 19 and 33 also find near-verbatim support in the specification as originally filed.

For example, FIG. 6 of the application as originally filed depicts an example method in which a processed (modified) web resource is sent to a client browser (110), and then, after the processed (modified) web resource is sent to a client browser, the original web resource is sent to the client browser (112). Thus, FIG. 6 provides near verbatim support for “after transmitting the modified web page source data to the remote client, transmitting the original web page source data to the remote client.”

Further, one portion of the Detailed Description of the Invention that describes FIG. 6 states:

At 112, the method further includes sending at least a portion of original web resource 30 that was size-optimized to the remote client in an original, unmodified state. Thus, the method 100 may include sending from acceleration device 18 to remote client 12 all of original web resource 30 in an original unmodified state, or may include sending only a portion of original web resource in an original unmodified state.⁶

⁵ MPEP 2163 (II)(A).

⁶ Emphasis added.

Application Number 09/680,998
Responsive to Office Action mailed August 15, 2006

Thus, the specification as originally filed expressly, or at least implicitly, supports the phrase "including the characters that were removed" in the limitation "after transmitting the modified web page source data to the remote client, transmitting the original web page source data to the remote client including the characters that were removed."

In the Office Action the Examiner stated, "the specification does not mention" the above-discussed limitations of claims 1, 19 and 33. For the reasons discussed above, this is obviously not the case. As discussed above, the specification provides near-verbatim support for these limitations.

The Examiner further stated "there is no mention of a mechanism that performs this particular function." This is also incorrect. The specification teaches that the method of FIG. 6 is performed by an acceleration device. Various embodiments of an acceleration device capable of performing the limitation at issue are discussed throughout the specification, including, for example, at FIGS. 3-5 and their associated description.

The Examiner additionally referred to the supposed lack of description of "necessary steps" or "an art-recognized methodology" to implement "after transmitting the modified web page source data to the remote client, transmitting the original web page source data to the remote client including the characters that were removed," and stated written description "would not allow one skilled in the art to envisage, make or use the inventive limitation." Applicant respectfully suggests that the Examiner appears to be confusing the issues of adequate written description and enablement. Applicant addresses the Examiner's enablement rejection below.

The issue for the written description requirement is whether the specification provides support for the claimed invention such that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention at the time of filing of the application. As discussed above, the specification and claims as originally filed provide near-verbatim support for the limitations at issue. Therefore, Applicant respectfully requests that the rejection under the written description requirement of section 112, first paragraph, be withdrawn.

Application Number 09/680,998
Responsive to Office Action mailed August 15, 2006

Enablement

The standard for enablement is whether the specification provides a description adequate to enable one of ordinary skill to practice the invention without "undue experimentation."⁷ There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to, the nature of the invention, the state of the prior art, the level of one of ordinary skill in the art, the level of predictability in the art, and the quantity of experimentation needed to make or use the invention based on the content of the disclosure.⁸

In the Office Action, the Examiner argued that Applicant's specification would not have enabled one of ordinary skill to practice the inventions recited in independent claims 1, 19 and 33. More particularly, the Examiner argued that Applicant's specification would not have enabled one of ordinary skill practice the last limitation of each of these claims, i.e., to transmit the original web page source data to the remote client, including the characters that were removed, after transmitting the modified web page source data to the remote client. Applicant respectfully disagrees with this conclusion.

As discussed above, Applicant's specification as originally filed describes transmitting the original web page source data to the remote client, including the characters that were removed, after transmitting the modified web page source data to the remote client.⁹ Moreover, Applicant's specification teaches that an acceleration device may perform this function.¹⁰ Applicant's specification provides extensive teaching regarding exemplary components and capabilities of example acceleration devices that would facilitate transmitting the original web page source data to the remote client, including the characters that were removed, after transmitting the modified web page source data to the remote client.

For example, Applicant's specification describes a number of examples of acceleration devices that are able to receive an original web page source data that includes non-renderable character data, that include a cache or other memory, and that are able to communicate with a

⁷ Emphasis added. See MPEP 2164.01, citing *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

⁸ MPEP 2164.01(a), citing *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

⁹ E.g., FIG. 6 and page 13, lines 10-22.

¹⁰ E.g., page 13, lines 17 and 18.

Application Number 09/680,998
Responsive to Office Action mailed August 15, 2006

remote client over a network.¹¹ Based on this description in Applicant's specification, a person of ordinary skill in the relatively predictable electrical and computer networking arts would have been enabled to practice transmitting the original web page source data to the remote client, including the characters that were removed, after transmitting the modified web page source data to the remote client. For example, based on this description, one of ordinary skill in the art would have been enabled to store original web page source data in the cache or other memory of an acceleration device, and, transmit the original web page source data from the acceleration device to the remote client, including the characters that were removed, after transmitting the modified web page source data to the remote client. Thus, Applicant's specification does enable this requirement of claims 1, 19 and 33.

In the Office Action, the Examiner argued that Applicant "has only mentioned a mechanism that can send a smaller version of an original image to a client, and thereafter send the original unmodified version of the image to the client...." The Examiner cited the description on pages 9, 13 and 18-20 as describing the mechanism that can send a smaller version of an original image to a client, and thereafter send the original unmodified version of the image to the client, by rewriting a hyperlink in the web page source data that will prompt the browser to request the original unmodified image. For example, at page 10, lines 2-7, Applicant's specification states:

Typically, the web server instructs the browser to download the original version of image data 33 by embedding a script (typically JavaScript) or other executable code in web page source data 32 for web page 40. This script is configured to rewrite the web page in the browser memory, such that the link 36_k that was used to point to the smaller version of the image data 33_a, is replaced with a link 36_m that points to an original version of the image data 33.

The Examiner's entire argument that Applicant's specification does not enable transmitting the original web page source data to the remote client, including the characters that were removed, after transmitting the modified web page source data to the remote client appears to be that Applicant's specification does not include an example similar to the quoted passage above for the situation in which the later-transmitted original web page source data includes non-renderable character data. However, the specification need not contain an example if the invention is otherwise disclosed in such manner that one skilled in the art will be able to practice

¹¹ E.g., FIGS. 1-6 and 14, page 5, lines 5-7, page 7, lines 21 and 22, page 8, lines 6-12, page 10, line 16 – page 11, line 8, page 11, lines 14-20, page 12, lines 3-14, page 13, lines 1-22.

Application Number 09/680,998
Responsive to Office Action mailed August 15, 2006

it without an undue amount of experimentation.¹² Furthermore, Applicant's claims do not require the use of a script to prompt a remote client to retrieve the original web page source data. In other words, Applicant's specification need only enable transmitting the original web page source data to the remote client, including the characters that were removed, after transmitting the modified web page source data to the remote client. For the reasons discussed above, Applicant's specification would have enabled one of ordinary skill to practice this limitation.

Moreover, contrary to the Examiner's argument, the example provided in Applicant's specification with respect to an original image does not demonstrate lack of enablement with respect to transmitting original web page source data including data non-renderable character data. Instead, this example would have further enabled one of ordinary skill in the art to transmit original web page source data including data non-renderable character data after transmitting the modified web page source data. In particular, one of ordinary skill in the art would have understood that the techniques described with respect to an original image, e.g., use of a script to rewrite a hyperlink, could have been used to instruct a browser on a remote client to download original web page source data including data non-renderable character data after receiving the modified web page source data with the non-renderable character data removed.

For at least these reasons, claims 1, 19 and 33 are enabled by the specification as originally filed. Therefore, Applicant respectfully requests that the rejection under the enablement requirement of section 112, first paragraph, be withdrawn.

Claim Rejections Under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1, 5-8, 9, 10, 13, 16-19, 23, 24, 27, 30-33, 35, 40 and 42 under 35 U.S.C. § 103(a) as being unpatentable over Theriault et al. (USPN 6,049,821), in view of Jungck (USPN 6,728,785), and in further view of Li (USPN 6,327,392). The Examiner rejected claims 2, 5 and 39 under 35 U.S.C. § 103(a) as being unpatentable over Theriault et al. in view of Jungck and Li, and in further view of Bodin et al. (USPN 6,311,223). The Examiner rejected claims 11, 25 under 35 U.S.C. § 103(a) as being unpatentable over Theriault et al. in view of Jungck, and in further view of Isaac et al. (USPN 6,424,981). The Examiner rejected claims 12, 26, 34, 36 under 35 U.S.C. § 103(a) as being unpatentable over Theriault et al. in view of Jungck and Li, and in further view of Hoffman et al. (USPN

¹² MPEP 2164.02, *citing In re Borkowski*, 422 F.2d 904, 908, 164 USPQ 642, 645 (CCPA 1970).

Application Number 09/680,998
Responsive to Office Action mailed August 15, 2006

6,615,266). The Examiner rejected claims 14, 15, 28, 29, 37 and 39 under 35 U.S.C. § 103(a) as being unpatentable over Theriault et al. in view of Jungck and Li, and in further view of Edlund et al. (USPN 6,546,388). The Examiner rejected claims 21 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Theriault et al. in view of Jungck and Li, and in further view of Burget (USPN 6,557,005).

Applicant respectfully traverses these rejections. The applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

The rejections under section 103 in the present Office Action are verbatim copies of the rejections in the previous Office Action. Applicant traversed these rejections in the previous Office Action. The Examiner did not respond to Applicant's traversal. Instead, the Examiner merely stated that Applicant's arguments were moot in view of the new grounds of rejection.

This statement is confusing. There do not appear to be any new grounds of rejection under sections 102 or 103. The only new grounds of rejection are the rejections under section 112, first paragraph. The rejections under section 112 do not in any way render Applicant's arguments with respect to the rejections under section 103 moot; particularly in view of the fact that the Examiner has maintained the rejections under section 103 without any change or comment.

To the extent that the Examiner intended to withdraw the section 103 rejections in favor of the section 112 rejections in view of the persuasive arguments presented in the Amendment filed June 28, 2006, Applicant respectfully requests that the Examiner do so. To the extent that the Examiner intends to maintain the 103 rejections, Applicant respectfully requests that the Examiner address the arguments presented in the Amendment filed June 28, 2006 in any subsequent Office Action. Applicant maintains traversal of the rejections under section 103 for the reasons stated in the Amendment filed June 28, 2006, which are included below for the convenience of the Examiner.

Application Number 09/680,998
Responsive to Office Action mailed August 15, 2006

Claims 1, 5-8, 9, 10, 13, 16-19, 23, 24, 27, 30-33, 35, 40 and 42

With reference to independent claims 1, 19 and 33, the applied references lack any teaching that would have suggested transmitting or sending original web page source data including characters of identified non-renderable character data that were removed to a remote client after transmitting or sending modified web page source data in which the characters were removed to the remote client.

The Examiner acknowledged that Theriault and Jungck fail to disclose or suggest this requirement of claims 1, 19 and 33. However, the Examiner argued that it would have been obvious to one of ordinary skill in the art "to modify Theriault by transmitting a modified page to a client, and transmitting the original page to the client in response to another request from the client for the original page," in view of the teachings within Li. Applicant respectfully disagrees with this conclusion.

As recognized by the Examiner, Li teaches allowing a user to observe a low-resolution, low-quality version of an image prior to deciding to request a full-resolution, high quality version of the image.¹³ Modification of an image, as taught by Li, is completely unrelated to removal of characters, as recited in Applicant's independent claims. Contrary to the Examiner's argument, transmitting an unmodified image in response to a user request would have in no way suggested transmitting or sending original web page source data including non-renderable characters that were removed.

Because Li is entirely focused on images, a person of ordinary skill in the art would have only looked to Li for teachings related to images. Accordingly, a person of ordinary skill in the art would not have looked to Li for modification of the way in which the Theriault proxy handled character data. In other words, if Li would have suggested any modification of the Theriault proxy, Li would have suggested modification of the manner in which the proxy handled images.¹⁴

However, a person of ordinary skill would not have considered any other modification of the Theriault proxy, much less modification such that the proxy would transmit or send original web page source data including characters of identified non-renderable character data that were removed after transmitting or sending modified web page source data in which the characters

¹³ Office Action, page 6; Li, col. 4, ll. 33-36.

¹⁴ Theriault, col. 15, ln. 66 col. 16, ln. 5, col. 17, ll. 39-50, col. 18, ln. 44 col. 19, ln. 56.

Application Number 09/680,998
Responsive to Office Action mailed August 15, 2006

were removed, as required by independent claims 1, 19 and 33. Accordingly, the combination of Theriault, Jungck, and Li would not have rendered this requirement of the independent claims obvious to a person of ordinary skill in the art.

For at least these reasons, the Examiner has failed to establish a *prima facie* case for non-patentability of Applicant's claims 1, 5-8, 9, 10, 13, 16-19, 23, 24, 27, 30-33, 35, 40 and 42 under 35 U.S.C. § 103(a). Withdrawal of these rejections is respectfully requested.

Claims 2, 5, 11, 12, 14, 15, 21, 22, 25, 26, 28, 29, 34, 36-39

As an initial matter, Applicant notes that none of Bodin, Isaac, Hoffman, Edlund, or Burget provides any teaching that would have overcome the deficiencies of Theriault, Jungck and Li with respect to the requirements of the independent claims discussed above. Further, Bodin, Isaac, Hoffman, Edlund, or Burget fail to disclose or suggest a number of the requirements of the claims against which they are applied.

For example, the applied references fail to disclose or suggest a method comprising identifying tags of web page source data having one or more uppercase characters, and rewriting the identified tags of the web page source data to have the same characters but in lowercase, as required by claim 2, as well as the similar requirement of claim 39. In the previous submission, Applicant amended claims 2 and 39 to clarify that they require the same characters, but in lowercase. The Examiner relied on Bodin for this requirement of claims 2 and 39.

However, Bodin fails to disclose or suggest rewriting tags to have the same characters, but in lower case. Instead, Bodin teaches "tokenizing" tags. Tokenizing tags, as taught by Bodin, involves removing letters from the tags, contrary to the requirements of claims 2 and 39.¹⁵ Accordingly, Bodin would not have suggested modification of the Theriault proxy to identify tags of web page source data having one or more uppercase characters, and rewrite the identified tags of the web page source data to have the same characters but in lowercase, as required by claims 2 and 39.

As other examples, the applied references fail to disclose or suggest removing data in the ASCII format, as required by claims 11 and 25, removing hard returns, as required by claim 36, or removing keywords configured to be interpreted by a search engine, as required by claims 15, 29 and 38. The Examiner acknowledged that Theriault fails to disclose or suggest these

Application Number 09/680,998
Responsive to Office Action mailed August 15, 2006

requirements of Applicant's claims. Moreover, Isaac, Hoffman and Edlund fail to disclose or suggest removing data in the ASCII format, hard returns, or keywords.

The Examiner did not assert that Isaac, Hoffman and Edlund disclose or suggest these requirements of Applicant's claims. Instead, the Examiner's position appears to be that, merely because data in the ASCII format, hard returns, and keywords are known to be part of web page source data, it would have been *per se* obvious to remove them. This conclusion is contrary to clear Federal Circuit precedent.

It is well established that the Examiner bears the burden of establishing a *prima facie* case of obviousness.¹⁶ In doing so, the Examiner must determine whether the prior art provides a "teaching or suggestion to one of ordinary skill in the art to make the changes that would produce" the claimed invention.¹⁷ This finding must be based upon substantial evidence, and not subjective musings or conjecture by the Examiner.¹⁸ A *prima facie* case of obviousness is established only when this burden is met.

In the present case, the Examiner has cited no teaching or suggestion in the prior art of removing data in the ASCII format, hard returns, or keywords, as required by Applicant's claims. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness for claims 11, 15, 25, 29, 36 and 38.

For at least these reasons, the Examiner has failed to establish a *prima facie* case for non-patentability of Applicant's claims 2, 5, 11, 12, 14, 15, 21, 22, 25, 26, 28, 29, 34, 36-39 under 35 U.S.C. § 103(a). Withdrawal of these rejections is requested.

¹⁵ Bodin, col. 6, ll. 1-20 (LOOKUP TABLE).

¹⁶ *In re Oeniker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

¹⁷ *In re Chu*, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995).

¹⁸ *Id.*

Application Number 09/680,998
Responsive to Office Action mailed August 15, 2006

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CONCLUSION

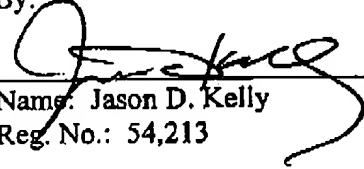
All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

Date:

November 15, 2006

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